

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of BRENDEL, et al.

Examiner: R. Desai

Application No.: 10/691,624

Art Unit: 1625

Filed: October 24, 2003

Title: 2'-SUBSTITUTED 1,1'-BIPHENYL-2-CARBOXAMIDES, PROCESSES FOR THEIR PREPARATION, THEIR USE AS MEDICAMENTS, AND PHARMACEUTICAL PREPARATIONS COMPRISING THEM

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Reply to Action Pursuant to 37 C.F.R. § 1.111

Sir:

This is responsive to the Action dated April 10, 2006 ("the Action") in connection with the above-identified patent application. Claims 1 to 8, 11 to 14 and 18 to 26 are pending in the present patent application. The Action includes a single rejection under the judicially created doctrine of obviousness-type double patenting. In view of the following remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1 to 8, 11 to 14 and 18 to 26 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent No. 6,531,495 to Brendel et al. ("the '495 patent") (Action at 2). In the first instance, Applicants wish to thank Examiner Desai for her time during a telephone conference on July 10, 2006 to discuss this rejection with Applicants' representatives, Raymond Parker, III and the undersigned. During the telephone conference, it was discussed whether the recitation "SO₂Me" in the definition of R(3) in claim 1 of the '495 patent was overlapping subject matter in view of the present claims. Applicants asserted that this recitation is superfluous

and gives no meaning to the claim because, although claim 1 recites that y cannot be 0 where R(16) is OR(17) or SO₂Me, R(16) *cannot* be SO₂Me because SO₂Me is not a variable included within the definition of R(16); as such there is no overlapping subject matter.

Notwithstanding, Applicants offered to submit a Request for Certificate of Correction for the '495 patent to remove the recitation of the term "SO₂Me" in the definition of R(3) in claim 1. Examiner Desai was favorably disposed to Applicants' offer. Accordingly, on August 9, 2006 Applicants have submitted such their Request for Certificate of Correction ("Exhibit A"). Accordingly, Applicants submit respectfully that the rejection is moot in view of Applicants' Request for Certificate of Correction.

Applicants submit respectfully that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested. If there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney at (908) 231-3410.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,

Dated: August 10, 2006

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